

REMARKS

Independent claims 1, 7 and 13 have been amended to recite that the first portion is the outer portion and the second portion is the inner portion. Support for this amendment is shown in the drawings and specification where first portion is identified as element 11 and second portion 31. These independent claims have also been amended to recite that the first outer portion is capable of conforming to the user's teeth after warming, and support for this is found, *inter alia*, on page 12, line 15 and following. The independent claims have further been amended to recite that the second inner portion produces a cushioning effect when compressed upon contact on the user during use. Support for this limitation is found, *inter alia*, on page 9, lines 23 and following.

Claims 1-4, 7-10, 12 and 14 have been rejected under 35 U.S.C. § 103(a) as obvious over Adell U.S. Patent No. 5,406,963 in view of Tucker U.S. Patent No. 6,045,359. Tucker has been cited solely as disclosing a tab or integral handle. Applicant respectfully traverses this rejection for the following reasons.

Adell discloses a two component tray in which the first component is molded or otherwise formed with holes, and then a second component is subsequently molded such that the second component passes through the holes to form a mechanical bonding of the components together. The main body, 10, supports and encloses the liner 12, which liner 12 is in contact with the teeth. Liner 12 is in both trough 16 and trough 18. Thus it can be said that the component that provides protection in Adell is liner 12, which is conformable to the teeth. In fact, liner 12 may or may not soften sufficiently to conform to the user's teeth, though it does in the preferred embodiment. Similarly, though it does not disclose the use of holes for bonding and is a dental impression device and not intended to protect the user, Tucker also has a rigid outer tray and the inner tray is conformable or impressionable to the user's teeth.

In contrast, Applicant has claimed a device that is directly opposite to the cited art. Rather than an inner tray that conforms to the teeth of the user, Applicant recites an inner tray of a gel that cushions the teeth but does not conform upon heating. The gel of the present invention does not soften to allow an impression to be made, and

has a memory such that it returns to undeformed form when pressure is removed. Thus, in use, the inner tray is a cushion that returns to a cushion form between blows. This is in total contrast to the cited art.

Similarly, Applicant has claimed a device in which the outer tray does conform to the user's mouth and gums, so that it is personalized and fits tightly in the mouth. In contrast again, Adell's outer tray is a plastic material that does not deform upon heating and is hard. Specifically, Adell says in column 3, beginning at line 5, that the liner ~~12~~ is tooth-impressionable and conforms to the teeth. This cannot protect the teeth as much as a cushion does, and thus leads one skilled in the art away from the invention completely.

Reconsideration of the rejection and withdrawal of the references is respectfully requested because the two components of the present invention function in direct opposition to the same components of the cited art. There is no hint of a suggestion that one would contravene the teachings of Adell, which is reinforced by Tucker, to do the opposite of what is taught. Only Applicant has made a mouthguard that repeatedly cushions the teeth by presenting a gel that is not formed into an impression of the user's teeth and that has an outer component that (1) holds the cushioning gel against the teeth and (2) itself is conformed by heating to the user's mouth for a more precise fit and careful positioning of the cushioning gel.

Claims 6 and 12 have been rejected under 35 U.S.C. § 103(a) as obvious over Adell U.S. Patent No. 5,406,963 in view of Tucker U.S. Patent No. 6,045,359, further in view of Kagekata et al. U.S. Patent No. 6,397,848. Kagekata et al. is said to disclose a styrene block copolymer, which is a gel. The reference does not disclose a two component mouthguard, but rather a single component guard. Kagekata et al does not disclose any material that conforms to the user under heat. The combination of references still does not teach or suggest the use of a conformed outer tray with a cushioning inner tray. Reconsideration and withdrawal of the rejection is earnestly solicited.

Finally, claims 5 and 11 have been rejected under 35 U.S.C. § 103(a) as obvious over Adell U.S. Patent No. 5,406,963 in view of Tucker U.S. Patent No. 6,045,359 and Kagekata et al. U.S. Patent No.

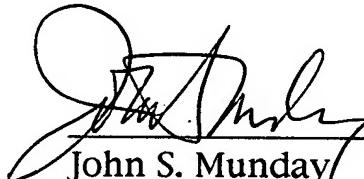
6,397,848, further in view of Wagner U.S. Patent No. 4,776,792. Wagner is no better reference than the previously discussed patents. Wagner's outer tray 1 does not conform to the user upon heating and the inner tray, in contact with the teeth does deform. This is because it is a dental impression tray. The concept of gel cushioning and outer tray conformation to the user is directly contrary to the teachings of this reference.

Once again, the Examiner is respectfully urged to reconsider the rejection and allow the claims. If the Examiner considers this case ready for conclusion other than by allowance, it is respectfully requested that the Examiner call Applicant's attorney at the number listed below.

Respectfully submitted  
SCOTT JACOBS

DATE: 11/10/04

By his Attorney



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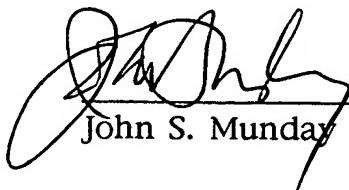
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I hereby certify that the attached correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: mail station amendment w/o fee, Commissioner for Patents, PO Box 1450, Alexandria, VA, 22313-1450, on the date appearing below.

DATE: 10 November 04

  
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